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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,705	10/28/2005	Toshiharu Takayama	2714-045309	2495
28289	7590	10/10/2007		
THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219			EXAMINER KIM, TAE W	
			ART UNIT 2876	PAPER NUMBER
			MAIL DATE 10/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/509,705	Applicant(s) TAKAYAMA	
	Examiner Tae W. Kim	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/10/06</u> , <u>3/9/06</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 5, 6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Brady (US 6100804 A).

Re claim 1: Brady discloses a communication device comprising a RFID part (1012 in figs 10B-10D) fixed on an insulation substrate (1002 in figs 10A-10D), wherein said insulation substrate is surface-mountable on a circuit board (col 10 lines 5-8 "chip-in-board" construction).

Re Claim 4: Brady discloses the communication device according to any one of claims 1-2, wherein fixture is achieved by resin molding (col 5 lines 41-48).

Re Claim 5: Brady discloses the communication device according to any one of claims 1-2, wherein electrical connection is achieved by wire bonding (col 7 line 65 – col 8 line 4) or flip-chip mounting.

Re Claim 6: Brady discloses the communication device according to any one of claims 1-2, said insulation substrate or said surface-mount chip antenna having a recess, wherein said RFID part is disposed in said recess (abst.: "aperture").

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Re Claim 8: Brady discloses a communication device package comprising a taping material or a bulk casing configured to package said communication device I according to any one of claims 1-2 (1500 in fig 15, col 14 lines 42-57).

3. Claims 2, 3, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Gnadinger (US 6268796 B1).

Re Claim 2: Gnadinger discloses a communication device (10 on fig 2) comprising a RFID part (50 in fig 2) fixed on a surface-mount chip antenna (20 in fig 2, col 3 lines 57-59), wherein an antenna terminal (52 in fig 2, col 5 lines 12-14) of said RFID part is electrically connected to a terminal (30 in fig 2 & 3, col 5 lines 26-31) of said surface-mount chip antenna (20 in fig 2, figs 3 & 4).

Re Claim 3: Gnadinger discloses the communication device according to claim 2, wherein said surface-mount chip antenna is a coil antenna (26 in fig 3, col 5 lines 4-6).

Re Claim 5: Gnadinger discloses the communication device according to any one of claims 1-2, wherein electrical connection is achieved by wire bonding or flip-chip mounting (col 5 lines 26-31).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brady (US 6100804 A) in view of Saliga (US 5469363 A).

Re Claim 7: Brady discloses the communication device according to any one of claims 1-2, wherein said communication device is a communication device placed on an electronic device or other products (1700 in 17A & 17B, 1900 in fig 19, 2000 in fig 20, 2100 in fig 21, 2200 in fig 22) completed through multiple process steps (figs 10A-10D; steps 1102-1120 in fig 11),

However, Brady does not disclose or fairly suggest said RFID part storing historical information about said process steps.

Saliga however discloses RFID part storing historical information about process steps (abst.: "electronic tag that keeps an unalterable log of each step in the handling of a controlled item")

Therefore, it would have been obvious at the time the invention was made to a person having ordinarily skill in the art to incorporate Saliga's teaching in Brady's device for the purpose of tracking the device's progress through the process of placing the device on other products.

#### *Conclusion*

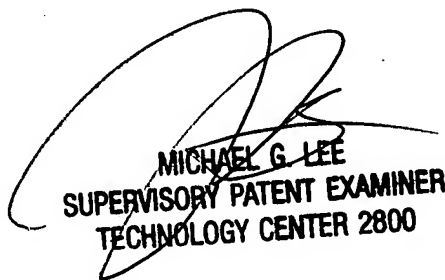
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae W. Kim whose telephone number is 571-272-5971. The examiner can normally be reached on Mon-Fri 7AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tae W. Kim  
Art Unit 2876  
Patent Examiner

TWK



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